REMARKS/ARUGMENTS

This communication is in response to the Final Office Action dated October 23, 2006 and Advisory Action mailed January 5, 2007. Claims 1-6 remain pending in this application with claim 1 being the only independent claim. Reconsideration in view of the amendments and remarks presented herein is respectfully requested.

Claims 1-6 remain rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,858,012 (Yamaki et al.) in view of JP 09-271488 (Iwao et al.).

Applicants respectfully traverse the prior art rejection of claims 1-6 for the reasons discussed below.

I. INDEPENDENT CLAIM 1

The Examiner in the January 5, 2007 Advisory Action maintains her rejection and states:

> "With regard to independent claim 1, applicant argues that Yamaki teaches the rear waist region is broader than the front waist region and Iwao teaches the front elastic area is broader than the rear elastic area; therefore the combination of Yamaki and Iwao do not teach or suggest a rear elastic area broader than a front elastic area as recited in claim 1. This argument is not persuasive because in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As noted by Applicant, Yamaki teaches a broader rear waist region in order to prevent exposure of the wearer's hips in the rear parts of the diaper even if the diaper slips down in the rear (c. 1, ll. 20-30). Iwao teaches a broader front elastic area in order to prevent the rear part of the diaper from sagging down past the hips in the rear parts of the diaper (abstr). Therefore, the combination of Yamaki and Iwao teach preventing the rear part of the diaper from slipping/sagging in the rear to prevent exposing the hips of the wearer by using a broader area either in the rear or the front which can be elasticated in order to prevent the wearer's hips from being exposed by the diaper slipping or sagging down in the rear part of the diaper."

Applicants respectfully traverse the Examiner's rejection of claim 1 as obvious over the combination of Yamaki et al. in view of Iwao et al. Claim 1 expressly states that the "rear elastic area" (which area is expressly defined in claim 1 as being formed by the rear waist elastic members) is broader than the "front elastic area" (which area is also expressly defined

in claim 1 as being formed by the front waist elastic members) with respect to the longitudinal direction of said absorbent body. Thus, in order to render the claimed invention obvious the prior art either alone or in combination thereof must disclose or suggest that an area formed by the rear waist elastic members is broader than an area formed by the front waist elastic members.

First addressing the primary reference, Yamaki et al. discloses:

> "Referring to FIG. 1, the elastic members 21 associated with the front and rear waist regions 6, 7 extend across the waist regions 6, 7 substantially at the same level above the bottom of the crotch region 8. Below the elastic members 21, the front and rear waist regions 6, 7 are additionally provided with a plurality of second elastic members 23. These second elastic members 23 each have a relatively large width of 3-10 mm and are stretchable circumferentially of the waist regions and bonded in their stretched conditions to an inner surface of at least one of the topsheet 17 and the backsheet 18. As shown, an upper end 27 of the rear waist region 7 sufficiently extends upward beyond the elastic members 21 to overlie an upper end 26 of the front waist region 6." (Col. 2, ll. 36-49)(emphasis added)

This passage of Yamaki therefore teaches that the rear waist region 7 is greater than the front waist region 6. The front and rear waist regions, 6, 7, respectively, however, are not analogous to the claimed area formed by the rear waist elastic members ("rear elastic area") and area formed by the front waist elastic members ("front elastic area"), respectively. There is no disclosure to support the inference that the elastic members 21 are disposed over the entire area of the front and rear waist regions. To the contrary, the underlined text in the quoted passage above from the Yamaki et al. specification expressly states that the rear waist region 7 extends upward beyond the elastic members 21 and thus clearly is not defined by an area formed by the rear waist elastic members, as expressly called for in claim 1. Accordingly, no inference may be made from the disclosure that the rear waist region is broader than the front waist region concerning the width in the longitudinal direction of either the "rear elastic area" (as formed by the rear waist elastic members 21) or the "front elastic area" (as formed by the front waist elastic members 21), much less, a comparison of one relative to the other, as found in claim 1.

Addressing the secondary reference, Iwao et al. discloses a front elastic area (W1) that is broader than a rear elastic area (W2). However, claim 1 calls for just the opposite. That is,

claim 1 requires that the "rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body".

Therefore neither reference alone discloses or suggests the claimed limitation. Furthermore, the combination of Yamaki et al. as modified by Iwao et al. would disclose a rear waist region 7 that is broader than a front waist region 6 and that the front elastic area (W1) is broader than a rear elastic area (W2). This combination still fails to teach "said rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body".

Accordingly Applicants assert that neither Yamaki et al. alone, or in combination with Iwao et al. render independent claim 1 obvious.

II. DEPENDENT CLAIMS 3-6

In the After Final Amendment filed on December 12, 2006 Applicants also traversed the outstanding prior art rejections with respect to dependent claims 3-6 by further distinguishing the claims over the prior art of record. The Examiner in the Advisory Action mailed January 5, 2007 did not specifically address these arguments but instead mere concluded that "Applicants arguments with respect to the dependent claims have been carefully considered but are not persuasive as these arguments rest entirely upon Applicants arguments with respect to independent claim 1, which have been addressed supra."(emphasis added) Applicants respectfully traverse the Examiner's statement and submit that had no additional basis for distinguishing claims 3-6 over the prior art of record been provided then since claims 3-6 depend from independent claim 1, their patentability would rest on the arguments presented with respect to claim 1. This, however, was not the case in that Applicants presented arguments or basis for distinguishing dependent claims 3-6 in addition to and separate from the arguments presented traversing the rejection of independent claim 1. Accordingly, Applicants assert that it was improper for the Examiner to fail to address the separate arguments for patentability with respect to those limitations found only in dependent claims 3-6. MPEP section 707.07(j) contemplates such a situation wherein a limitation or subject matter found only in a dependent claim is found to be

allowable and thus identified as such by the Examiner as being objected to but would be in condition for allowance if rewritten in independent form to include the limitations of the base claim and all intervening claims.

Accordingly, Applicants again resubmit below for the Examiner's consideration the arguments or basis (previously presented in the After Final Amendment filed on December 12, 2006) further distinguishing dependent claims 3-6 over the prior art of record. Pursuant to U.S. Patent Office procedure the Examiner's consideration of each of these arguments separately from and in addition to the arguments presented above with respect to independent claim 1 is required.

A. Dependent Claim 3

Claim 3 provides "the distance between said waist opening elastic members and the portion of said rear waist elastic members closest to said waist opening elastic members is approximately equal to said distance between each rear waist elastic member and its adjacent rear waist elastic member". In rejecting claim 3, the Examiner states " With respect to claim 3, as seen in Figure 2, Yamaki et al. disclose the distance between the waist opening elastic members (21) and the portion of the rear waist elastic members (23) is approximately equal to the distance between each rear waist elastic member (23) and is adjacent rear waist elastic member (23)." (October 23, 2006 Final Office Action; p. 4, ll. 1-4)

Applicants respectfully traverse the Examiner's rejection. Figure 2 of Yamaki et al. is merely a plan view of the diaper unfolded back and forth from its state shown in Figure 1. In Figure 1, the distance between the elastic member 21 and the portion of the elastic members 23 in the rear region 7 is greater (approximately 2 times greater) than the distance between each elastic member 23 and its adjacent elastic member 23 in the rear waist region 7. Applicants submit that the Examiner has improperly relied on the scale of the drawings alone, absent any disclosure in the specification, to teach this claimed limitation. MPEP §2125 provides "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir.

2000) (The disclosure gave no indication that the drawings were drawn to scale. '[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.')".

Yamaki et al. fails to indicate that the drawings are drawn to scale. Accordingly, any measurements based on the drawings alone, especially in light of the inconsistency in the scale of related figures in the drawings, is not a proper basis for rejecting the claimed invention.

Applicants also wish to address the Examiner's comments in the Response to Arguments section wherein she states that "Applicants' arguments with regard to dependent claims 2-6 have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claim 1, which have been addressed *surpa*." (October 23, 2006 Final Office Action: Page 8, lines 13-15) Despite the dependency of dependent claims 2-6 from independent claim 1, the arguments traversing these prior art rejections submitted herein and in the previous August 2, 2006 Amendment are independent of those presented with respect to claim 1. Accordingly, should the rejections not be overcome by the arguments presented herein, Applicants request that the Examiner state her reasoning with respect to this and the other dependent claims.

B. <u>Dependent Claims 4-6</u>

As best understood by Applicant's representative, the Examiner in the Final Office Action mailed October 23, 2006 appears to be posing multiple arguments with respect to dependent claims 4-6. On the one hand the Examiner maintains that the limitations found in dependent claims 4-6 are expressly taught by Yamaki et al.

Claim 4 states that the "absorbent core is arranged so as not to overlap said front elastic area while overlapping at least a part of said rear elastic area". In the Final Office Action the Examiner asserts that in Yamaki et al. "the absorbent core (38) is arranged so as not to overlap the front waist elastic area (26) while not overlapping at least a part of the rear elastic area (26) (col. 2, ll. 35-65; col. 1, ll. 40-51; abstract, penultimate lines)." (October 23, 2006 Final Office Action; Page 4, lines 9-11)

Similarly, claims 5 and 6 each provide "said absorbent core is arranged so as not to

overlap said rear elastic area while overlapping at least a part of said front elastic area". In the Final Office Action the Examiner states that Yamaki et al. teaches that "the absorbent core (38) is arranged so as not to overlap the rear elastic area (26) while overlapping at least a part of the front elastic area (27)." (October 23, 2006 Final Office Action: Page 5, lines 10-11)

Applicants respectfully disagree with the Examiner's interpretation of the claimed front elastic area reading on front end (26) in Figure 2 of Yamaki et al. Claim 1, from which claims 4-6 each depends, expressly states "said rear waist elastic members form a rear elastic area in said rear waist region" while "said front waist elastic members form a front elastic area in said front waist region". Clearly, in Figure 2 of Yamaki et al. the absorbent 2 including absorbent core 38 overlaps front and rear elastic members 23 which define the front elastic area and a rear elastic area, respectively. Accordingly, Yamaki et al. fails to disclose or suggest that the absorbent core is arranged so as not to overlap the front elastic area (as found in claim 4) or the rear elastic area (as found in claims 5 and 6).

On the other hand the Examiner appears to assert in the alternative that with respect to claims 4-6 the combination of Yamaki et al. and Iwao et al. fail to teach the location of the core in either the front or the rear of the diaper. Nevertheless, the Examiner maintains that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the absorbent core in the front or rear as is known in the diaper art since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, USPQ 70." (October 23, 2006 Final Office Action: Page 6, lines 1-7)

Applicants disagree with the Examiner's interpretation of the rule of law from *In re Japikse*. MPEP §2144.04 (VI)(C) entitled "Rearrangement of Parts" cites *In re Japikse* stating that "Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held obvious because shifting the position of the starting switch would not have modified the operation of the device." (emphasis added) Thus, *In re Japikse* does not provide a per se ruling as adopted by the Examiner that any rearrangement of parts taught by a prior art reference is an obvious unpatentable modification. Instead, *In re Japikse* stands for the proposition that rearrangement of the position of a part relative to the teaching of a prior art reference renders the claim obvious only if such rearrangement would not have modified the operation of the device. Arrangement of the absorbent core so as not to

overlap the rear elastic area while overlapping at least a part of the front elastic area, as found in claim 1, modifies the functionality of the diaper as expressly disclosed in the specification.

> "The absorbent core 4 is provided so as to partially overlap the rear elastic area 25. Therefore, even if the absorbent core 4 is positioned so as to extend into the rear waist region 13 and the front waist region 15 to the same extent, the absorbent core 4 closely fits at the front waist side of the wearer. In other words, the embodiment shown in Fig. 6 prevents leakage without the absorbent core 4 extending into the rear waist region 13 any further than necessary." (Specification: Page 21, lines 12-20) (Similar language with respect to the partial overlap of the absorbent core in the front elastic area is disclosed on Page 23, lines 4-12)

Applicants therefore submit that as expressly taught in the specification of the present application arrangement of the absorbent core, as claimed, modifies the operation of the device. Accordingly, Yamaki et al. fails to render the claimed arrangement of the absorbent core obvious.

MPEP section §2144.04 (VI)C further states "However, 'The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.' *Ex part Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." (emphasis added) In the present case, Yamaki et al. fails to provide a motivation or reason in the prior art reference, absent improper use of the specification of the present invention as a template, for arrangement of the absorbent core as claimed. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

For the foregoing reasons Applicants submit that independent claims 1-6 are patentable over the art of record. Applicants submit that the application is now in condition for allowance and passage to issuance is requested.

CONDITIONAL PETITION FOR EXTENSION OF TIME

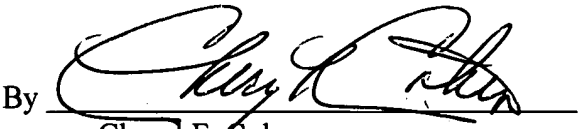
If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 503462.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 503462.

Respectfully submitted,

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